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NIXON PEABODY LLP			HSU, RYAN	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/612,806	<b>Applicant(s)</b> ENGLMAN ET AL.	
	<b>Examiner</b> RYAN HSU	<b>Art Unit</b> 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 35-66 and 69 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 35-66 and 69 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

In response to the Request for Continued Examination (RCE) under 37 CFR 1.114 filed on 2/13/09. Claims 35 and 54 have been amended and claims 1-34 and 67-68 were previously canceled. Claims 35-66 and 69 are pending in the current application.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 35-48, 52-65 and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baerlocher et al. (US 6,648,754 B2) and Torango (US 6,241,608 B1) and further in view of Toranago (US 2002/0042297 A1).**

Regarding claims 35, 40, and 54, Baerlocher teaches a method of playing a bonus game with a bonus payoff comprising: conducting a wagering game at a gaming terminal and activating the bonus game entry award and displaying a plurality of player-selectable game elements during a bonus game and via player inputs selecting at least one of the plurality of player-selectable game elements and awarding the bonus game payoff in response to the player selecting a certain set of player-selectable game elements (*see Fig. 5(a-c) and the related description thereof*). Furthermore, Baerlocher teaches in the prior art of record player selectable game elements that award a credit award to the player in response to selecting at least one of the player selectable game elements that are not in the certain set of player selectable elements. Baerlocher teaches an 'accept' and 'reject' offer which allows the player to continue selecting or

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accepting the award that is currently offered. This limitation is met as if the player selects the 'accept' button the award is credited to the player. If the player selects and still has enough 'offers' available then the player is provided with player selectable elements to try and win the progressive prize (*see Fig. 3, 5-6 and the related description thereof*). However, Baerlocher is silent with respect to an embodiment where the bonus game is specified as a progressive game.

In an analogous gaming patent, Torango teaches a progressive games or pari-mutuel games which are well known in the art to incorporate a jackpot or bonus award using a percentage of the wagers made by a player at a game machine. Torango teaches the basic principles of a progressive gaming machine as described in the limitations of the instant claims (*see col. 2: ln 25-col. 4: ln 55*). These progressive games have also been adapted to be used with networked gaming machines and therefore can take a percentage of several game machines at the same time to provide the player with a large jackpot or credit award. Progressive prizes however only determine the source of a credit award in a game and does not actually change or alter the play of a game. The effect of the progressive system taught in Torango teach accepting a player wager at a gaming terminal of a plurality of gaming terminals, each of the plurality of gaming terminals being eligible for at least one progressive game payoff and funding the progressive game payoff from a percentage of the player wagers including the player wager at the plurality of gaming terminals. Furthermore, progressive prizes are old and well known in the art and have been used to provide large bonus prizes to be awarded to users. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the expected advantage of a progressive payoff instead of the bonus game payoff that is taught in Torango with the invention of Baerlocher so that a player could be offered a larger bonus prize.

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Several examples of Progressive bonus prizes are shown in the following patents to show its state in the art: (Mullins - (US 6,210,276 B1), Wood (US 5,286,023), and Okuda et al. (US 6,224,484 B1)). However, Baerlocher and Torango are not specific with respect to teaching a progressive game payoff where a player may select a sequence of a plurality of player-selectable game elements to be awarded a progressive payoff.

In a related gaming patent, Torango teaches that a player may qualify for several different progressive prizes. When such an event occurs Torango teaches that the system would present the available prizes to the player based on criteria such as amount of the wager, player rating or others. Additionally, the gaming available teaches that a selection button enables the player to select from the menu of different progressive prizes available (*see Fig. 7 and the related description thereof, paragraph [0195]*). One would be motivated to incorporate the features of Torango with that of Baerlocher and Torango at the time the invention was made to enable a player a more interactive experience and adapt the game to provide for the various needs of the various users. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the feature of Torango with that of Baerlocher and Torango to provide a progressive game that allowed a player to eligibility to at least one progressive game payoff based upon the selection of a user.

Regarding claims 36 and 55, Baerlocher teaches a player-selectable game element including a continue-game element that allows for the continuation of the bonus game and a stop-game element that stops the bonus game and upon the receiving of a continue-game input providing the player with an award (*see Fig. 5(a-c) and the related description thereof*).

Regarding claims 37 and 45, Baerlocher teaches a method wherein the sequentially selecting one of the continue-game elements increases the bonus game payoff (*see elements [30,32, 100,122] of Fig. 5c and the related description thereof*).

Regarding claims 38-39, 56 and 62-63, Baerlocher teaches a method wherein the bonus game includes a first and second game payoff wherein the second game payoff is higher than the first game payoff and selecting a predetermined number of continue-game elements or a predetermined number of level-increasing elements allow the player to achieve a second game payoff (*see Fig. 6 and the related description thereof*). Additionally, it is understood that in a progressive gaming environment that the bonus prizes are funded from a percentage of the player wagers from the plurality of gaming terminals.

Regarding claim 41, Baerlocher teaches a bonus game wherein a player selects from a plurality of bonus game qualifying items and they are displayed on the game machine display in order to determine the overall payoff for the user (*see Fig. 6 and the related description thereof*). However, Baerlocher is silent with respect to these qualifying items as been video envelopes. Video Envelopes in the instant invention simply act as item icons or display or theme art and do not would be a simply matter of design choice by the game programmer. As it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate a video envelope design into the player selectable components of Baerlocher's bonus game and expect the operation of the game to still meet the limitations of the instant invention.

Regarding claims 42, 48, and 58, Baerlocher teaches a method wherein the game includes first and second game payoffs and the first and second game payoffs are displayed on signage located above the gaming terminal (*see Fig. 6 and the related description thereof*). If the

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applicant's contends Baerlocher's ability to display the progressive bonus outputs the Examiner would like to enact OFFICIAL NOTICE that the display of awards on a signage display is extremely old and well known in the art. Furthermore, the Examiner cites the following references as examples of a signage device (**Okuda et al. (US 6,224,484 B1) - Figs. 2-3 and the related description thereof; Wood (US 5,286,023) -Figs. 1 and 6 and the related description thereof).**

Regarding claims 43, 57-58 and 65, Baerlocher teaches a method wherein the steps of conducting, achieving, activating, and displaying and determining a randomly selected outcome are performed by a CPU internal or local to the gaming terminal (*see col. 5: ln 60-col. 6: ln 7*).

Regarding claims 44, 59 and 69, Baerlocher teaches a method of playing a bonus game at a gaming terminal that has a first bonus game payoff and a second bonus game payoff comprising: receiving from the gaming terminal at least one player input during the bonus game and in response to the receiving of player inputs determining whether the player input achieves a first bonus game payoff or a second bonus game payoff and the second bonus game payoff being greater than the first bonus game payoff (*see Fig. 5(a-c) and the related description thereof*). Additionally, Baerlocher teaches a first selection of player inputs yielding a first bonus game payoff and a second selection of player inputs yielding a second bonus game payoff and awarding the player a corresponding one of the first and second bonus game payoffs (*see Fig. 6 and the related description thereof*). However, Baerlocher is silent with respect to teaching a bonus payoff in the form of a progressive system.

In an analogous gaming patent, Torango teaches a progressive games or pari-mutuel games which are well known in the art to incorporate a jackpot or bonus award using a

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percentage of the wagers made by a player at a game machine. Torango teaches the basic principles of a progressive gaming machine as described in the limitations of the instant claims (*see col. 2: ln 25-col. 4: ln 55*). These progressive games have also been adapted to be used with networked gaming machines and therefore can take a percentage of several game machines at the same time to provide the player with a large jackpot or credit award. Progressive prizes however only determine the source of a credit award in a game and does not actually change or alter the play of a game. The effect of the progressive system taught in Torango teach accepting a player wager at a gaming terminal of a plurality of gaming terminals, each of the plurality of gaming terminals being eligible for at least one progressive game payoff and funding the progressive game payoff from a percentage of the player wagers including the player wager at the plurality of gaming terminals. Furthermore, progressive prizes are old and well known in the art and have been used to provide large bonus prizes to be awarded to users. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the expected advantage of a progressive payoff instead of the bonus game payoff that is taught in Torango with the invention of Baerlocher so that a player could be offered a larger bonus prize. Several examples of Progressive bonus prizes are shown in the following patents to show its state in the art: (Mullins - (US 6,210,276 B1), Wood (US 5,286,023), and Okuda et al. (US 6,224,484 B1)).

Regarding claims 46-47 and 60-61, Baerlocher teaches a method wherein the gaming terminal includes a display and the display for displaying a plurality of player-selectable game elements and at least one player input corresponding to the one of the plurality of player-selectable game elements (*see elements [108(a-x)] of Fig. 5c and the related description*



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*thereof*). Additionally, Baerlocher teaches the activation of a touch screen positioned over one of the plurality of player-selectable game elements (*see 'touch screen' and 'touch screen controller' [50-52] Fig. 2 and the related description thereof*). Furthermore, the player selectable elements when selected are opened to reveal an outcome (*see Fig. 5(a-c) and the related description thereof*).

Regarding claims 52-53, Baerlocher teaches a method wherein the determining is performed by a CPU internal to the gaming terminal or external to the gaming terminal (*see col. 5: ln 60-col. 6: ln 7*).

Regarding claim 64, Baerlocher teaches a continue-game element that includes a credit element the credit element provides the player of the bonus game with a credit award (*see Fig. 4(a-b) and the related description thereof*).

**Claims 49-51 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baerlocher and Torango and Torango as applied to claims above, and Baerlocher et al. (US 6,599,192) and further in view of Weingardt et al. (US 5,275,400).**

Regarding claims 49-51, Baerlocher and Torango teach a progressive gaming system that provides a player with player selectable elements to determine a progressive prize. However Baerlocher and Torango are silent with respect to a progressive game qualifying round for determining whether the gaming terminal is permitted to enter the progressive game and play for the progressive prize.

In an analogous gaming patent, Baerlocher teaches an selection provided to the user that asks whether the player would like to 'jump' or 'bail' on the prize in order to qualify for the next progressive prize (*see Figs. 3-6 and the respective related description thereof*). One would be

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motivated to incorporate such a feature as to provide the player with predictable result of adding an additional element of risk/reward to the user before they qualify for a larger prize. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the features of Baerlocher with that of Baerlocher and Torango at the time the invention was made as it would create the expected result of providing the player with a more thrilling experience. However, Baerlocher is silent with respect to providing a progressive game in response to higher amounts being wagered in a basic game at the gaming terminal.

In an analogous gaming patent, Weingardt teaches providing different levels of progressive prizes and probabilities to users that play more per basic game of the gaming machine (*see Figs. 3-4 and the related description thereof*). Weingardt teaches that providing this feature would yield the predictable result of giving the players an incentive to wager more per game. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the feature of providing a player a larger prize if the player wagered more per play of the basic game.

**Claim 66 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baerlocher et al. and Torango and Torango as applied to claims above, and further in view of Okuda et al. (US 6,224,484 B1).**

Regarding claim 66, Baerlocher teaches a gaming system that allows a player to be offered a progressive game payoff. However, Baerlocher is silent with respect to a gaming terminal that includes a connection port. In an analogous gaming patent, Okuda teaches a gaming terminal that includes a connection port for coupling the gaming terminal to signage located adjacent to the gaming terminal for displaying a progressive game payoff (*see Fig. 1 and*

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*the related description thereof*). One would be motivated to incorporate a connection port into the game terminal of Baerlocher in order to allow the gaming device to display signage information and attract customers. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the features of Okuda with that of Baerlocher to create the expected result of a gaming machine that could communicate with an outside display device and attract customers.

### ***Response to Arguments***

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communication from the examiner should be direct to Ryan Hsu whose telephone number is (571)-272-7148. The examiner can normally be reached on M-F 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hotaling can be reached at (571)-272-4437.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, contact the Electronic Business Center (EBC) at 1-866-217-9197 (toll-free).

/John M Hotaling II/  
Supervisory Patent Examiner, Art Unit 3714  
RH  
April 27, 2009